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18

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/273,957	03/22/99	WANG	H GC477C1

GENENCOR INTERNATIONAL  
925 PAGE MILL ROAD  
PALO ALTO CA 94304

HM22/0621

EXAMINER

MAYHEW, B

ART UNIT	PAPER NUMBER
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1652

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DATE MAILED:

06/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/273,957

Applicant(s)  
Wang et al.

Examiner  
Bradley S. Mayhew

Group Art Unit  
1652



- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-58 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-58 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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***Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 56-58 drawn to phenol oxidizing enzymes, classified in class 435, subclass 189.
- II. Claims 18-53, drawn to polynucleotides encoding phenol oxidizing enzymes, vectors comprising said polynucleotides, host cells comprising said vectors, and recombinant methods for expressing the encoded phenol oxidizing enzymes, classified in class 435, subclass 69.1.
- III. Claims 54-55, drawn to cultures of *Stachybotrys* strains, classified in class 435, subclass 254.1.

The inventions are distinct, each from the other because of the following reasons:

The products of Groups I, II and III are unrelated. The polypeptides of Group I and the polynucleotides of Group II each comprise chemically unrelated structures capable of separate manufacture, use and effect. The product of Group III is a living organism unrelated to chemical structures of Groups I and II. The polynucleotides comprise nucleic acid sequences while the polypeptides comprise amino acid sequences. Additionally, the polynucleotides have other utility besides encoding the proteins, such as a hybridization probes, and the polypeptides have utility such as in methods of oxidizing phenol. And the product of Group III has utility other

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than as a source of the products of Groups I and II, such as a being a source of other commercially useful enzymes.

The expression process of Group II is related to the product of Group I as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product, or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case, the polypeptide of Group I can be obtained by a process materially different from the recombinant expression methods of Group II, such as purification from naturally occurring sources.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

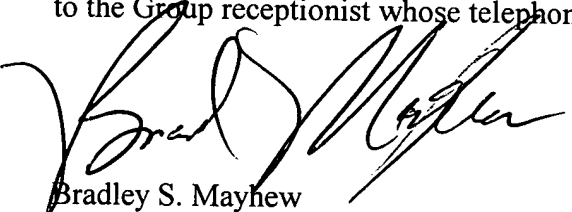
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*Advisory Information*

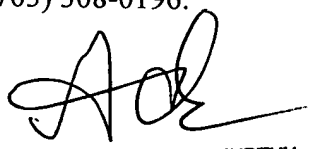
1. **Any inquiry concerning this communication or earlier communications should be directed to Bradley S. Mayhew whose telephone number is (703) 308-9437. The examiner can normally be reached Monday-Thursday from 8:30 am to 6:00 pm.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu N. Achutamurthy, can be reached at (703) 308-3804. The fax phone number for Official and Unofficial Papers to the Examiner is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Bradley S. Mayhew  
June 19, 2000



PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600